

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33

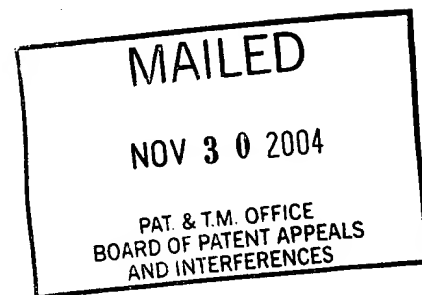
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PING LIONG TJOA

Appeal No. 2004-1180
Application No. 09/319,243

HEARD: NOVEMBER 17, 2004



Before COHEN, STAAB, and BAHR, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

REMAND TO THE EXAMINER

Before taking up the appeal on its merits, we find it necessary to remand this application to the examiner for appropriate action with respect to the matters listed below.

File History

The following summary of relevant portions of the prosecution history of the present application is provided as a starting point in explaining the issues requiring the examiner's attention.

- On October 12, 2001, the examiner issued an office action (Paper No. 15) rejecting claims 12 and 14-23 as being unpatentable over Bosko. In rejecting the claims, the examiner took the position that it would have been obvious to one of ordinary skill in the art "to incorporate [in the device of Bosko] spherical elements adapted to fit the palm and a total length spanning the shoulder span of a person [using the device]" (page 2).
- On February 12, 2002, appellant submitted a request for reconsideration (Paper No. 17) of the rejection. The claims were not amended.
- On June 4, 2002, the examiner issued a final office action (Paper No. 19) again rejecting claims 12 and 14-23 as being unpatentable over Bosko, the rationale for the rejection being "as set forth in the previous Office Action" (page 2).
- On December 4, 2002, appellant submitted a request for reconsideration (Paper No. 21) of the final rejection. The claims were not amended. The request included certain attachments purporting to be evidence of nonobviousness. The request included the following statement:

To further supplement the material submitted, applicant is submitting herewith the brochure noted above and two (2) declarations under 37 CFR [§] 1.132 for the examiner's consideration. These declarations were drafted by the undersigned on information presented to the undersigned from applicant's German attorney. The declarations are presently being executed and will be filed in due course. For the present they are being submitted unsigned. They are, nevertheless accurate and a faithful reproduction of the information provided to the undersigned." [Request for Reconsideration, pages 2-3.]

- On January 14, 2003, the examiner issued an advisory action (Paper No. 22) informing appellant that the request for reconsideration (Paper No. 21) had been considered but did not place the application in condition for allowance because it did not present arguments that overcome the final rejection set forth in Paper No. 19.
- On March 31, 2003, appellant submitted a brief on appeal. Attached to the brief were two (2) executed declarations under 37 CFR § 1.132, a brochure relating to the claimed invention, and an additional exhibit also relating to the claimed invention. The brief included arguments relying in part on the executed declarations, brochure and exhibit.
- On June 18, 2003, the examiner issued an examiner's answer (Paper No. 24) maintaining the rejection of claims 12 and 14-23 as being unpatentable over Bosko. The examiner's findings which respect to Bosko were set forth on page 4 of the answer, wherein the examiner found, among other things, that the weight training device of Bosko included end elements having a spherical form "the diameter of which may be adapted to the palm of the hand," and wherein the total length of the training device "[has] the capacity to span the length of the shoulder span of the person using it." The statement of the rejection did not specify any differences between the Bosko device and the subject matter of independent claim 12. In the examiner's statement of obviousness (answer, page 5), the examiner concluded that it would have been obvious to incorporate into Bosko certain dimensions for portions of the weight training device, all of which related to limitations found in dependent claims. The answer was silent as to the executed declarations, brochure and exhibit submitted with the brief on appeal.

- On August 15, 2003, appellant submitted a reply brief, which included the following statement:

In applicant/appellant's Brief, reference was made to . . . two (2) brochures and to declarations under 37 CFR [§] 1.132. No mention of these was made in the Examiner's Answer. Accordingly, applicant/appellant contacted the examiner by telephone and asked the examiner if any consideration was given to this evidence. Applicant/appellant was advised that consideration was given. However, no mention is made of this evidence This evidence must be given its proper consideration, and if such proper consideration is given the allowance of the noted claims will, it is respectfully submitted, follow. [Reply brief, page 3.]

- On October 16, 2003, the examiner issued an advisory letter (Paper No. 26) stating that the reply brief "[had] been entered and considered."

Issues requiring the examiner's attention

The above prosecution history raises several questions that need to be addressed by the examiner. ¹such as whether the examiner has modified his theory of unpatentability in the answer, and ²whether the submissions accompanying appellant's brief on appeal have been entered and considered. Accordingly, this application is remanded to the examiner under the authority of 37 CFR § 41.50(a)(1) for appropriate action as follows.

¹ (1) The examiner shall identify what the differences are between the weight training device of Bosko and the subject matter of each of the appealed claims, and in particular,

independent claim 12. In so doing, the examiner shall state whether the limitations of claim 12 calling for the claimed apparatus to have spherical end elements of a diameter "adapted to the palm of the hand" and a total length "approximately in the range of the length of the shoulder span of the person using it" are "obvious" in view of Bosko (as per the rejection of Paper No. (15)) or "disclosed" (and thus fully met) by Bosko (as per the answer).

(2) If the examiner determines that there are no differences between the subject matter of any appealed claim and Bosko, the examiner shall take appropriate action (e.g., enter a rejection of that claim under 35 U.S.C. § 102 as being anticipated by Bosko), or explain why such action has not been taken.

(3) The examiner shall state for the record which, if any, of appellant's submissions accompanying the main brief have been entered.


(4) With respect to any such submission entered, the examiner shall fully treat the submission on the record, explaining why the submission is or is not sufficient to overcome the rejection(s).

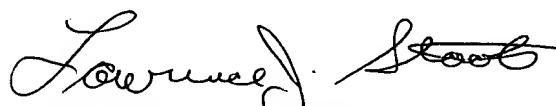
A supplemental examiner's answer fully responsive to (1) through (4) above is authorized, if appropriate.

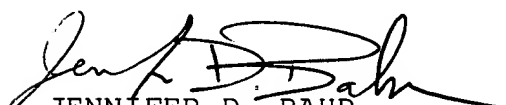
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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED


IRWIN CHARLES COHEN)
Administrative Patent Judge)


LAWRENCE J. STAAB)
Administrative Patent Judge)


JENNIFER D. BAHR)
Administrative Patent Judge)

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